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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/734,019	12/11/2003	Jun Ozaki	035576/270591	2349

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EXAMINER

ASHTON, ROSEMARY E

ART UNIT	PAPER NUMBER
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1752

DATE MAILED: 09/23/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/734,019

Applicant(s)

OZAKI, JUN

Examiner

Rosemary E. Ashton

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 June 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 9 and 10 is/are allowed.
- 6) ☒ Claim(s) 1-6 is/are rejected.
- 7) ☒ Claim(s) 7 and 8 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- 1) ☒ Certified copies of the priority documents have been received.
 - 2) ☐ Certified copies of the priority documents have been received in Application No. _____.
 - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>6/10/04, 11/12/03</u> | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION

1. The prior art of JP 2003-292496 is removed from the rejection because applicant submitted a certified translation of the foreign priority document.
2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
3. Claims 1-6 are rejected under 35 U.S.C. 103(a) as being unpatentable over JP 10-282654 in view of Yamaguchi (CAplus abstract DN 132:293809) and Toyoda et al US patent application publication no. 2004/0175655.

As shown in the Derwent abstract JP 282654 teaches an image forming composition comprising an acid generating compound, a polymer having one phenolic group with a molecular weight of 1200, an alkali soluble resin, an infrared absorbing agent and a crosslinking agent.

It does not teach the crosslinking agent is a silane coupling agent meeting the limitations of formula 1 and 2 in the instant application.

Yamaguchi teaches the silane coupling agents meeting the limitations of formula 2 in the instant application. As shown in the CAplus abstract (132:293809) the compounds having formula 2 have a nitro-phenyl group, G2 is COO, R5 is (CH₂)_m, m is 4, X2 is trimethoxysilyl.

Toyoda et al teaches a composition comprising a silane coupling agent as a crosslinking agent. The silane coupling agent is used for the purpose of increasing the adhesiveness of the composition (sec. 56).

As shown above, the primary reference JP 282654 teaches the claimed reagents in an image forming composition, however, it does not teach the claimed silane coupling compounds having formula 1 or formula 2 are in the composition.

It would have been obvious to one of ordinary skill in the art to use the silane coupling agents taught in JP 2003-292496 (CAplus abstract DN 139:29235) or the silane coupling agents taught in with a Yamaguchi with a reasonable expectation of obtaining a composition having improved adhesiveness

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because Toyoda teaches that when silane coupling agents are used as crosslinking agents the composition has increased adhesiveness.

Response to Arguments

4. Applicant's arguments filed 29 June 2005 have been fully considered but they are not persuasive. Applicant argues against the combination of art in that there is not motivation to combine the art. This is not persuasive because the motivation is provided by Toyoda in that the use of the silane crosslinking improves adhesiveness of the composition between the cured product and a material contacting the cured product (sec. 56).

Applicant also argues the secondary references do not teach an IR absorbing agent, however, the primary reference teaches this reagent. The only reagent lacking in the primary reference is the silane crosslinking agent.

Allowable Subject Matter

5. Claims 7,8 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

6. The following is a statement of reasons for the indication of allowable subject matter: The prior art does not teach the phenolic polymer is one of the polymers in claim 8 or a lithographic printing as in claim 9.

7. Claims 9,10 are allowed.

The following is an examiner's statement of reasons for allowance: No prior art was found having the compounds of formulas I or II.

Conclusion

8. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

9. Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Rosemary E. Ashton whose telephone number is 571-272-1326. The examiner can normally be reached on Mon-Fri, 11:00-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cynthia Kelly can be reached on 571-272-1526. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through

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Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>.

Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Rosemary E. Ashton
Primary Examiner
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A handwritten signature in cursive script, appearing to read "R Ashton".

September 16, 2005

ROSEMARY ASHTON
PRIMARY EXAMINER